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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/417,845

10/14/1999

TATSUYA SHIMOJI

2406-2

8022

22204

7590

06/17/2004

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WASHINGTON, DC 20004-2128

EXAMINER

BELIVEAU, SCOTT E

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 06/17/2004

11 /

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/417,845

Applicant(s)

SHIMOJI ET AL.

Examiner

Scott Beliveau

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
4a) Of the above claim(s) 1-9, 25-27 and 29-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-24 and 28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5-8.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Claims 1-9, 25-27, and 29-69 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1 April 2004.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

3. Figures 1-7 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference character(s) mentioned in the description: 500 502 (Page 3, Lines 14-15). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement

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Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 522 (Figure 5), 20, 46, 52, 54, 76 (Figure 7). Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification and associated drawings.

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7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested:
- Method and system for receiving and recording digital broadcast programs.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 16-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the examiner is unclear as to where enabling support is found for “fetch[ing] all target fetch control data without specifying which fetch control data to fetch” or “fetch[ing] all target navigation data without specifying which navigation control data to fetch”. Furthermore, the claim language appears contradictory in so far as it requires the fetching of targeted information without actually specifying what is actually being specified.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 10-13, 22-24 and 28 are rejected under 35 U.S.C. 102(a) as being anticipated by Shimoji et al. (EP 827336) of record.

In consideration of claim 10, the Shimoji et al. reference discloses a “digital broadcast receiver” [5121] that allows a “viewer to switch content elements selected” in response to an “operation input by the viewer” through a remote control. As illustrated in Figure 4, the “digital broadcast receiver” comprises a “receiving portion for receiving transmitted data” [5122] (Page 23 – Section 1-3-1), an “operation receiving portion for receiving an operator operation” [5127] (Page 25 – Section 1-3-5), a “restoring portion” [5123/5124/5126] for “determining which content element to restore next based on the operation received by the operation receiving portion and in accordance with the navigation control data, for selecting a content element to be restored next out of content elements transmitted repeatedly, and for restoring the element for output in a receiving mode; for restoring and recording a set of navigation control data and a set of content elements, in a recording mode; and for selecting a content element from a set of content elements for output, based on the operation received by the operation receiving portion in accordance with the recorded navigation control data, in a reproducing mode” (Page 10, Lines 37-51; Page 25, Lines 4-12, 29-36; Page 30, Line 14 – Page 34, Line 28).

Claims 11-13 are rejected wherein “said restoring portion fetches a target content element from elementary streams in accordance with fetch control data for identifying content elements with a series of sequential information attached thereto in accordance with said series of information” or “time information” in the “receiving mode and recording mode” (Page 25, Line 53 – Page 30, Line 12). The “content elements are dynamic video image data or audio data which are sliced in said elementary streams in accordance with a start time and termination time of said time information” or “are still video image data which are sliced in said elementary streams in accordance with said time information” (Page 9, Lines 16-20; Page 11, Line 33 – Page 12, Line 7)

Claim 22 is rejected in wherein Figure 4 illustrates a “digital broadcast recorder” [5121] that enables a viewer to “switch to content elements selected in response to an operation input by the viewer” (Page 9, Lines 13-15). The “digital broadcast recorder” comprises a “receiving portion for receiving transmitted data” [5122] (Page 23 – Section 1-3-1) and a “recording portion” [5125/5126/5128] that “fetches a target content element from elementary streams in accordance with fetch control data for identifying content elements with a series of sequential information attached thereto in accordance with said series of information, and which restores a set of content elements for recording thereof as well as records a set of navigation control data” (Page 23, Line 39 – Page 25, Line 51).

Claims 23 and 24 are rejected in view of claim 10 wherein the “digital broadcast receiver” [5121] with associated “recording medium which records a program for allowing a CPU to perform reception processing” (Page 25, Section 1-3-9) further comprises a “receiving portion for receiving transport streams” [5122], an “operation receiving portion

for receiving an operator operation” [5127], a “transport decoder for selecting at least desired navigation control data and content elements from received transport streams in accordance with the operator operation for output” [5123], an “extending decoder for extending output from the transport decoder” [5124], a “CPU for controlling each of the aforementioned portions” with an “associated memory which records a program for determining control contents of said CPU” [5126], and a “recording portion for recording” [5125].

Claim 28 is rejected in wherein Figure 4 illustrates a “digital broadcast recorder” [5121] that enables a viewer to “switch to content elements selected in response to an operation input by the viewer” (Page 9, Lines 13-15). The “digital broadcast recorder” comprises a “receiving portion for receiving transmitted data” [5122] (Page 23 – Section 1-3-1), an “operation receiving portion for receiving an operator operation” [5127] and a “restoring portion” [5123/5124/5126] for “determining which content element to restore next based on the operation received by the operation receiving portion and in accordance with link information in the content elements, for selecting a content element to be restored next out of content elements transmitted repeatedly, and for restoring the element for output, in a receiving mode; for restoring and recording a set of content elements, in a recording mode; and for selecting a content element from a set of recorded content elements for output, based on the operation received by the operation receiving portion in accordance with link information in the content elements, in a reproducing mode” (Page 10, Lines 37-51; Page 25, Lines 4-12, 29-36; Page 30, Line 14 – Page 34, Line 28).

12. Claims 10, 22-24 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Goodman et al. (US Pat No. 6,427,238).

In consideration of claim 10, the Goodman et al. reference discloses a “digital broadcast receiver” [22] that allows a “viewer to switch content elements selected” in response to an “operation input by the viewer” through a remote control. As illustrated in Figure 2, the “digital broadcast receiver” comprises a “receiving portion for receiving transmitted data” [31/32/33], an “operation receiving portion for receiving an operator operation” [35], and a “restoring portion” [30]. The “restoring portion” subsequently “determining which content element to restore next based on the operation received by the operation receiving portion and in accordance with the navigation control data, for selecting a content element to be restored next out of content elements transmitted repeatedly, and for restoring the element for output in a receiving mode; for restoring and recording a set of navigation control data and a set of content elements, in a recording mode; and for selecting a content element from a set of content elements for output, based on the operation received by the operation receiving portion in accordance with the recorded navigation control data, in a reproducing mode” (Col 3, Lines 50-61; Col 6, Lines 5-46; Col 10, Lines 1-51).

For example, the system downloads a directory module that specifies “content elements” or other modules to restore on an as needed basis associated with the user operation (Col 1, Lines 33-48). Accordingly, the terminal utilizes navigation control data associated with the directory module to restore the appropriate element or module which may reside either in the memory of the terminal or in the transport stream.

Claim 22 is rejected in wherein Figure 2 illustrates a “digital broadcast recorder” [22] that enables a viewer to “switch to content elements selected in response to an operation input by the viewer”. The “digital broadcast recorder” comprises a “receiving portion for receiving

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transmitted data” [31/32/33] and a “recording portion” [30] that “fetches a target content element from elementary streams in accordance with fetch control data for identifying content elements with a series of sequential information attached thereto in accordance with said series of information, and which restores a set of content elements for recording thereof as well as records a set of navigation control data” (Col 3, Lines 50-61; Col 4, Lines 22-23; Col 6, Lines 5-67; Col 10, Lines 1-51).

Claims 23 and 24 are rejected in view of claim 10 wherein the “digital broadcast receiver” [22] with associated “recording medium which records a program for allowing a CPU to perform reception processing” [36] (Col 5, Lines 32-34) further comprises a “receiving portion for receiving transport streams” [31], an “operation receiving portion for receiving an operator operation” [35], a “transport decoder for selecting at least desired navigation control data and content elements from received transport streams in accordance with the operator operation for output” [32], an “extending decoder for extending output from the transport decoder” [33], a “CPU for controlling each of the aforementioned portions” [35] with an “associated memory which records a program for determining control contents of said CPU” [36], and a “recording portion for recording” [37] (Col 5, Lines 2-42; Col 7, Lines 44-54).

Claim 28 is rejected in wherein Figure 4 illustrates a “digital broadcast recorder” [22] that enables a viewer to “switch to content elements selected in response to an operation input by the viewer”. The “digital broadcast recorder” comprises a “receiving portion for receiving transmitted data” [31], an “operation receiving portion for receiving an operator operation” [35] and a “restoring portion” [30] for “determining which content element to restore next

based on the operation received by the operation receiving portion and in accordance with link information in the content elements, for selecting a content element to be restored next out of content elements transmitted repeatedly, and for restoring the element for output, in a receiving mode; for restoring and recording a set of content elements, in a recording mode; and for selecting a content element from a set of recorded content elements for output, based on the operation received by the operation receiving portion in accordance with link information in the content elements, in a reproducing mode” (Col 3, Lines 50-61; Col 6, Lines 5-46; Col 10, Lines 1-51).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoji et al. (EP 827336), in view of Watanabe et al. (EP 830019).

In consideration of claims 20 and 21, Shimoji does not particularly disclose nor preclude the particular usage of an expiration time in conjunction with content elements. The Watanabe et al. reference discloses a similar a “digital broadcast receiver” [121] wherein “said restoring portion” [123/124/126] “associates an expiration date transmitted corresponding to a set of content elements or a set of fetch control data” or content elements or fetch control data” respectively “with the set of content elements for recording thereof in the recording mode; and does not output said set of content elements if said expiration date has expired or outputs the same together with information that said expiration date has expired, in the reproducing mode” (Col 15, Lines 31-57; Col 41, Line 23 – Col 43, Line 42). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to utilize an “expiration date” such as that disclosed by Watanabe et al. in conjunction with content elements for the purpose of providing a means by which the associated content is utilized only if it is still relevant (Watanabe et al.: Col 13, Lines 7-22).

16. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoji et al. (EP 827336), in view of Mori et al. (EP 827340).

In consideration of claims 13 and 14, the Shimoji et al. reference does not explicitly disclose nor preclude that the particular determination that all navigation control data or content elements have been recorded in accordance with a received list. The Mori et al. reference discloses a particular technique wherein a “restoring portion determines whether or

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not all content elements included in the sets of content elements” or “navigation control data included in sets of navigation data have been recorded” in accordance with a “received list” outlining associated elements (Col 21, Lines 29-41; Col 25, Lines 24-50). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to determine what sub-set of available information has been actually “recorded” for the purpose of providing a means for reducing the associated wait time while still optimizing memory usage associated with an one-way interactive television broadcasts (Mori et al.: Col 2, Line 58 – Col 3, Line 9).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Shimoji et al. (EP 823823) reference discloses a digital broadcasting system comprising a digital broadcast receiver that is operable to receive and reproduce cyclically multiplexed interactive data.
- The Broadwin et al. (US Pat No. 5,903,816) reference discloses a system and method for displaying still video images related to video content in an interactive broadcast television system.

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- The Chernock et al. (US Pat No. 6,177,930) reference discloses an interactive presentation system that receives a plurality of series of digital data segments on a cyclic basis and further enables a link between sets based on navigation data.
- The Wang (US Pat No. 6,675,385) reference discloses an MPEG-2 digital TV headend that encodes HTML web pages into data carousel for both real-time and cached loading.
- The Mao et al. (US Pat No. 6,459,427) reference discloses a one-way broadcasting system that comprises a headend system architecture adapted to receive data from the Internet and transmit the data through a digital TV network to receivers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907.

The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

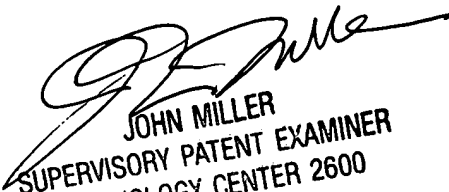
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SEB

June 10, 2004


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